

REMARKS

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 1, 16, 20, 23, and 29-32 have been amended, claims 27 and 34 have been cancelled without prejudice, and new claims 36-37 have been added. Support for any new claims is found in the specification, claims, and drawings as originally filed, and no new matter has been added. Accordingly, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Rejections

Rejection Under 35USC Section 112 Second Paragraph

Claim 28 has been rejected under 35 USC Section 112, subparagraph 2, as being indefinite for failing to particularly point and distinctly claim the subject matter which the Applicant regards as the invention.

In light of the amendment to base claim 23, Applicants believe that the indefiniteness rejection of claim 28 has been overcome, and thus it is submitted that the rejection under 35 USC Section 112, paragraph 2 should be withdrawn.

Rejection Under 35USC Section 102(b)

Claims 1-9 and 29 have been rejected under 35 USC Section 102(e), as being anticipated by U.S. patent application publication 20030123079 to Yamaguchi et al. ("Yamaguchi "). Applicants respectfully traverse the rejection and request reconsideration based on the amendment to claims 1 and 29 and features in the other claims which are neither

disclosed nor suggested in the cited reference.

As to a rejection under 102(e), "[a]nticipation is established only when a single prior art reference discloses expressly or under the principles of inherence, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc.*, (1984, CAFC) 221 U.S.P.Q. 385. The standard for lack of novelty, that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. *Schroeder v. Owens-Corning Fiberglass Corp.*, 514 F.2d 901, 185 U.S.P.Q. 723 (9th Cir. 1975); and *Cool-Fin Elecs. Corp. v. International Elec. Research Corp.*, 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Independent claim 1 (amended), and its dependent claims 2-9, are patentably distinguishable over the cited reference because claim 1 emphasizes the novel features of the present invention which prints selected digital images from among all the various images that are associated with a particular web page. In this regard, claim 1 recites a method of printing with a printing system that includes:

“analyzing a web page with the printing system to identify image files associated with the web page;

filtering the image files with the printing system according to predetermined criteria indicative of at least one file characteristic so as to identify certain ones of the image files as qualified image files;

selecting at least one of the qualified image files; and

printing the selected ones of the qualified image files.” (emphasis added)

Conversely, the Yamaguchi reference is directed to printing entire web pages in a manner that reduces network traffic. The Yamaguchi reference discloses “an image forming apparatus which can directly obtain data of a WWW server on a network without passing through an information processing apparatus and can reduce a load which is applied to the network when the data obtained from the WWW server is printed” (paragraph [0009]). In

operation, client 9 sends over the network to copier 1 only the URL of the web page to be printed, and then copier 1 retrieves the web page from a WWW server 10,11 on the network and prints it. Network traffic is thus approximately reduced in half compared to an operating model where client 9 retrieves the entire web page from WWW server 10,11 itself, and then turns around and provides that entire web page to copier 1 to be printed (FIG. 1; paragraphs [0004]-[0006], [0085-0086]).

Significantly, the Yamaguchi reference teaches nothing about filtering the various image files that are associated with the web page, and then selecting and printing one or more of the image files that satisfy the filtering criteria, as is recited in Applicants' claim 1. Filtering, as described in Applicants' specification from page 17, line 11 to page 21, line 2, involves identifying as qualified image files those ones of the image files associated with the web page that satisfy predetermined criteria that are indicative of at least one file characteristic. It is only those qualified image files which then may be selected and printed.

The Office states that at "paragraphs [0113], and [0116]-[0189], reference shows a plurality of options available to a user that filter image content and output which is analogous to the claim limitation" (Office Action, p.5). Applicants believe the Office's statement is incorrect. Paragraphs [0116]-[0189] describe the content of the 38 different settings for the Web Pull Print function of copier 1. These settings collectively define the formatting and timing of the print output to be produced by copier 1 for the URL specified in setting number 2. For example, various ones of the settings define whether a document title will be printed on the page header (setting number 1), how many copies of the web page will be printed (setting number 30), and how the printing operation will be scheduled (setting number 34). However, of those 38 different settings, not a single one refers to image file characteristics, filtering criteria indicative of these characteristics, or image file filtering operation.

The novel features of the present invention are not anticipated by the Yamaguchi reference in that the filtering limitation of Applicants' claim 1 is absent from the Yamaguchi reference. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claim 29 (amended) is patentably distinguishable over the cited reference because claim 29 emphasizes the novel features of the present invention which prints selected digital images from among all the various images that are associated with a particular web page. In this regard, claim 29 recites a printing system that includes:

“means for analyzing a web page with the printing system to identify image files associated with the web page;

means for filtering the image files with the printing system according to qualifying criteria indicative of at least one image file characteristic so as to identify certain ones of the image files as qualified image files;

means for selecting at least one of the qualified image files for printing; and

means for printing the at least one selected one of the image files.” (emphasis added)

For similar reasons as have been explained heretofore with regard to claim 1, the novel features of the present invention are not anticipated by the Yamaguchi reference in that the means for filtering limitation of Applicants’ claim 29 is absent from the Yamaguchi reference. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Rejection Under 35USC Section 103

As to a rejection under 103(a), the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be

found in the prior art, and not based on applicant's disclosure.

In the present case, the applied references do not teach or suggest all of Applicant's claim limitations.

Dependent claims 10, 13-15, and 35 have been rejected under 35 USC Section 103(a), as being unpatentable over U.S. patent application publication 20030123079 to Yamaguchi et al. ("Yamaguchi ") in view of U.S. patent 6,141,111 to Kato. Applicants respectfully traverse the rejection and request reconsideration based at least on the dependence of these claims on independent claim 1, whose reasons for allowability over Yamaguchi have been discussed heretofore and against which Kato has not been cited.

Dependent claim 11 has been rejected under 35 USC Section 103(a), as being unpatentable over U.S. patent application publication 20030123079 to Yamaguchi et al. ("Yamaguchi ") in view of U.S. patent 6,141,111 to Kato, and further in view of U.S. patent 6,784,925 to Tomat et al. ("Tomat"). Applicants respectfully traverse the rejection and request reconsideration based at least on the dependence of this claim on independent claim 1, whose reasons for allowability over Yamaguchi have been discussed heretofore and against which Kato and Tomat have not been cited.

Claims 20-26 and 31 have been rejected under 35 USC Section 103(a), as being unpatentable over U.S. patent 6,141,111 to Kato in view of U.S. patent application publication 20030123079 to Yamaguchi et al. ("Yamaguchi "). Applicants respectfully traverse the rejection and request reconsideration based on the amendment to claims 20, 23, and 31 and features in the claims which are neither disclosed nor suggested in the cited references, taken either alone or in combination.

Independent claim 20 (amended), and its dependent claims 21-22, are patentably distinguishable over the cited references because claim 20 emphasizes the novel features of the present invention which determine the web location of image files selected for printing

from an identity marker printed on an image file proof sheet. In this regard, claim 20 recites a method of printing with a multifunction printing system which includes:

“automatically analyzing a web page to identify image files associated with the web page;

printing a proof sheet for at least some of the image files, the proof sheet having an image identifier, at least one identity marker indicative of a web location for each of the at least some of the image files, and at least one corresponding selection area for each of the at least some of the image files;

marking at least one of the selection areas corresponding to at least one of the image files to be printed;

optically scanning the marked proof sheet so as to determine marked selection areas; determining from the at least one identity marker the web location for those ones of the image files associated with the marked selection areas; and

printing the image files associated with the marked selection areas.” (emphasis added)

Claim 20 has been amended to include limitations similar to claim 12, which the Office has deemed allowable if rewritten in independent form. Neither the Kato reference nor the Yamaguchi reference, alone or in combination, teach or suggest at least the limitations of printing a proof sheet having at least one identity marker indicative of a web location for each of the at least some of the image files, and determining from the at least one identity marker the web location for those ones of the image files associated with the marked selection areas.

Applicants respectfully traverse the Office’s assertion that the claimed combination of Applicants’ invention is obvious to a person having ordinary skill in the art. Such could be possible only in hindsight and in light of Applicants’ teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claim 23 (amended), and its dependent claims 24-26, are patentably distinguishable over the cited references because claim 23 emphasizes the novel features of the present invention which uses filter criteria indicative of at least one image file characteristic to obtain certain ones of the image files that are associated with a specified web page. In this regard, claim 23 recites a multifunction printing system which includes:

“a web page analyzer subsystem for identifying image files associated with a specified web page and for obtaining certain of the image files that satisfy filter criteria indicative of at least one image file characteristic;

an image proofing subsystem coupled to the web page analysis subsystem for forming a user-markable proof sheet having an indicia of each of the certain image files and a user-designation area associated with each indicia;

a proof sheet analyzer subsystem adapted to identify the user-designated ones of the certain image files from the marked proof sheet and obtain the user-designated ones of the certain image files; and

an image printing subsystem coupled to the proof sheet analyzer subsystem for printing the user-designated ones of the image files.” (emphasis added)

The Kato reference describes "a unified structure of a color copier and a digital still camera" to "provide an image printing system ... capable of ... printing rapidly and easily" (col. 2, lines 18-22; emphasis added). An image "is first taken by the digital still camera ... and the obtained image data are transferred to the image printer via, for instance, a serial cross cable or a PC card memory" (col. 6, lines 13-16). The Kato reference teaches or suggests nothing about identifying image files associated with a specified web page, or obtaining certain of the image files that satisfy filter criteria indicative of at least one file characteristic.

Nor does the Yamaguchi reference, as has been explained heretofore with reference to claim 1, teach or suggest anything about obtaining certain of the image files associated with a specified web page that satisfy filter criteria indicative of at least one file characteristic.

Neither the Kato reference nor the Yamaguchi reference, alone or in combination, teach or suggest the novel features of the present invention in that at least the limitation of obtaining certain of the image files associated with a specified web page that satisfy filter criteria indicative of at least one file characteristic are absent from these references.

Applicants respectfully traverse the Office's assertion that the claimed combination of Applicants' invention is obvious to a person having ordinary skill in the art. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claim 31 (amended) is patentably distinguishable over the cited references because claim 31 emphasizes the novel features of the present invention which determine the web location of image files selected for printing from an identity marker printed on an image file proof sheet. In this regard, claim 31 recites a multifunction printing

system which includes:

“means for identifying and obtaining certain image files associated with a web page;
means for forming a user-markable proof sheet having an indicia of each of the certain image files, at least one identity marker indicative of a web location for the certain image files, and a user-designation area associated with each indicia;

means for identifying the user-designated ones of the certain image files from the marked proof sheet;

means for determining from the at least one identity marker the web location for each of the user-designated ones of the certain image files;

means for obtaining the user-designated ones of the certain image files; and
 means for printing the user-designated ones of the image files.” (emphasis added)

Claim 31 has been amended to include limitations similar to claim 12, which the Office has deemed allowable if rewritten in independent form. Neither the Kato reference nor the Yamaguchi reference, alone or in combination, teach or suggest at least the limitations of means for forming a proof sheet having at least one identity marker indicative of a web location for the certain image files, and means for determining from the at least one identity marker the web location for each of the user-designated ones of the certain image files.

Applicants respectfully traverse the Office’s assertion that the claimed combination of Applicants' invention is obvious to a person having ordinary skill in the art. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Claims 32 and 33 have been rejected under 35 USC Section 103(a), as being unpatentable over U.S. patent 6,657,702 to Chui et al. (“Chui”) in view of U.S. patent 6,141,111 to Kato. Applicants respectfully traverse the rejection and request reconsideration based on the amendment to claim 32 and features in the claims which are neither disclosed nor suggested in the cited references, taken either alone or in combination.

Independent claim 32 (amended), and its dependent claim 33, are patentably distinguishable over the cited references because claim 32 emphasizes the novel features of the present invention which analyzes a web page with the printing system to identify image files associated with the web page, and filters the identified image files with the printing system to determine the qualified ones of the image files that are associated with a specified

web page. In this regard, claim 32 recites a method of printing with a printing system which includes:

“analyzing a web page with the printing system to identify image files associated with the web page;

filtering the identified image files with the printing system to determine the qualified ones of the image files;

printing a proof sheet for qualified ones of the image files, the proof sheet having an image identifier and a corresponding image specifier for each qualified one of the image files; providing at least one of the image specifiers to the printing system; and printing the image file associated with each of the provided image specifiers.”
(emphasis added)

The Chui reference describes an ordering system for prints of digital images. In this system, “after the photo-finisher is in possession of the user’s digital images, the photo-finisher can make them available to the user online, for example, by hosting the images on a web page at which the user can view and access the images using a browser application ... [T]he user accesses the photo-finisher's website to designate which of the images should be printed, parameters relating to printing (e.g., finish, size, number of copies), and one or more recipients to whom the prints are to be sent” (col. 13, line 66 – col. 14, line 8). However, the Chui reference teaches or suggests nothing about analyzing the web page with the printing system to identify image files associated with the web page, as recited in Applicants’ claim 32. Such an analysis operation is not performed by the Chui reference; it is unnecessary because the system of the Chui reference already possesses the digital images, and produces the web page based on its prior knowledge of the digital images in order to “hav[e] the user view the images online, for example, with a browser and selectively designate which images should be printed” (col. 14, lines 50-52). Conversely, in Applicants’ invention, the image files that are associated with the web page are not known to the printing system in advance. In order to identify these image files, the printing system analyzes the markup text of the web page (Fig. 8). Furthermore, the Chui reference teaches or suggests nothing about filtering the identified image files with the printing system to determine the qualified ones of the image files.

Nor does the Kato reference, as has been explained heretofore with reference to claim 23, teach or suggest identifying image files associated with a web page, or filtering the

identified image files with the printing system to determine the qualified ones of the image files.

Neither the Chui reference nor the Kato reference, alone or in combination, teach or suggest the novel features of the present invention in that at least the limitations of analyzing the web page with the printing system to identify image files associated with the web page, and filtering the identified image files with the printing system to determine the qualified ones of the image files are absent from these references.

Because claim 32 has been amended to include the limitations of canceled claim 34, Applicants further note that, as has been discussed heretofore with reference to claim 1, the Yamaguchi reference, taken alone or in combination with the Chui and Kato references, does not teach or suggest the at least the limitation of filtering the identified image files with the printing system to determine the qualified ones of the image files.

Applicants respectfully traverse the Office's assertion that the claimed combination of Applicants' invention is obvious to a person having ordinary skill in the art. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Formalities

Amendment of the Specification

The paragraph beginning at page 2, line 13 of the specification has been amended as required by the Office to delete an unnecessary hyperlink.

The paragraph beginning at page 24, line 1 of the specification has been amended to conform to the revision of FIG. 7.

These amendments are formal in nature and do not alter the scope of the claims or constitute new matter.

Amendment of the Drawings

FIGS. 1A, 1B, and 7 have been amended as required by the Office to overcome the

objections made thereto. The amendments are formal in nature and do not alter the scope of the claims or constitute new matter.

Allowable Subject Matter

Claims 12 and 16-19 have been objected to as being dependent upon a rejected base claim and have been indicated as being allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Claim 28 has been indicated as allowable if rewritten to overcome the rejections under 35 U.S.C. 112, second paragraph, and to include all of the limitations of the base claim and any intervening claims.

With this Amendment, Applicants have rewritten allowable claim 16 in independent form to include all of the limitations of the base claim (claim 1) and any intervening claims (none). As rewritten claim 16 is now believed to be in allowable form, Applicants respectfully submit that its dependent claims 17-19 are allowable in dependent form. Applicants, therefore, respectfully request that the objection to claims 16-19 be withdrawn and that these claims be deemed allowed.

As the rejections of the base claims for dependent claims 12 and 28 have been traversed herein, dependent claims 12 and 28 have not been rewritten at this time. Applicants reserve the right to rewrite the claims in independent form at a future time.

Conclusion

Attorney for Applicant(s) has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at

the below-listed telephone number.

**AUTHORIZATION TO PAY AND PETITION
FOR THE ACCEPTANCE OF ANY NECESSARY FEES**

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



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AMENDMENTS TO THE DRAWINGS

The attached sheets of drawings includes changes to Figs. 1A, 1B, and 7. These sheets replace the original sheets.

In Fig. 1A, incorrect reference designator 60' has been changed to 60, and reference designator 120 not mentioned in the description has been deleted.

In Fig. 1B, reference designator 22 has been changed to 22', and reference designator 120 not mentioned in the description has been deleted.

In Fig. 7, incorrect reference designator 9' has been changed to 92.

Attachment: Replacement Sheets (3)